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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,820	10/07/2004	Robert P. Rouen	68.0496	5819

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SCHLUMBERGER RESERVOIR COMPLETIONS  
14910 AIRLINE ROAD  
ROSHARON, TX 77583

EXAMINER
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ANDREWS, DAVID L

ART UNIT	PAPER NUMBER
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3672

NOTIFICATION DATE	DELIVERY MODE
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03/10/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

VSOLIS2@SLB.COM

ABrown15@rosharon.oilfield.slb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,820	<b>Applicant(s)</b> ROUEN, ROBERT P.	
	<b>Examiner</b> David Andrews	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-16,18-20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-16,18-20 and 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/7/2007 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The amendment filed 11/25/2009 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 11/25/2009 have been fully considered but they are not persuasive. Although applicant's amendment has overcome the 102 rejection under Maloney, it does not overcome a combination of McCulloch and Maloney as below.

Applicant argues that the combination of McCulloch and Maloney is defective because the unloading valves of Maloney are on the productions string and therefore one of ordinary skill in the art would not be led to the combination resulting in the claimed invention of the valves on a separate sidestring. The examiner disagrees because it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter, but simply what the combination of references makes obvious to one of ordinary skill in the art. *In re Bozak*, 163 USPQ 545 (CCPA 1969). In this case, one of ordinary skill would recognize that the lift capability of McCulloch could be improved by providing spaced gas lift valves, as taught by Maloney et al., and would be led to place them on the tubing 40 because in the system of McCulloch one of ordinary skill would recognize that below the packer 23 the "production tubing" is essentially the casing 18, and therefore the only way to incorporate gas lift valves, as taught by Maloney et al., would be to place them on the tubing 40, resulting in the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-11, 13-15, and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCulloch (US 2,894,587) in view of Maloney et al. (US 4,708,595). McCulloch discloses a gas injection tool, system and method comprising: a tubular member (40) defining an axial bore therethrough, the axial bore adapted to deliver a gas into a wellbore proximate a perforation interval via an orifice (col. 3, line 51-52, injection of any fluid; col. 4, lines 32-40, may be any length proximate the perforations as shown), wherein the gas injection tool is separate from and not in contact with a tubing string for removing fluid from the wellbore (fig 1); wherein the tubular member is configured to engage a sealing mechanism (23) that seals the wellbore above the perforation interval (fig 1); wherein the tubular member is adapted to inject a gas proximate the perforation interval of a gas-bearing or oil bearing well (would equivalently work with either); a retrieving element (48) attached to the tubular element; a tubular string (22) adapted to produce fluid from the perforation interval via one port in the sealing mechanism (fig 1); wherein the sealing mechanism is a dual port packer (fig 1); and wherein the tool is configured to be deployable into the wellbore separately from the tubing string (fig 1).

McCulloch does not disclose a plurality of gas lift valves on the tool. Maloney et al. disclose a gas injection tool, system and method comprising a sidestring (28) through a dual port packer, wherein the sidestring has a plurality of gas lift valves (30) which are adapted to regulate communication, via orifices, from the axial bore of the sidestring to the wellbore at or below a perforation interval (fig 1, 21 is open to wellbore fluids) and are configured to be opened in response to application of pressure applied by a flow of gas injected into the axial bore of the tubular member (col. 3, lines 28-37), wherein the gas is injected through each of the gas lift valves that is opened to assist production of fluid from the wellbore (col. 1, lines 50-58, col. 4, lines 32-34); wherein the tubular string comprises one or more gas lift valves (36) for injecting a gas into the well at a location above the sealing mechanism, wherein the gas lift valves are arranged on a side of the tubular to enable injected gas to pass in a radial direction of the tubular member into the wellbore through corresponding orifices (fig 1), wherein the gas lift valves are separate from the tubular string (col. 4, lines 30-33). It would have been obvious to one of ordinary skill in the art to include multiple orifices with gas lift valves on the injection tool and production string of McCulloch, as taught by Maloney et al., in order to provide additional production assist means since combining prior art elements according to known techniques to yield predictable results is considered obvious to one of ordinary skill.

Claims 16, 18-20, 22, 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCulloch (US 2,894,587) in view of Maloney et al. (US 4,708,595)

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and further in view of Wellington et al. (US 5,031,697). McCulloch and Maloney et al. disclose all the limitations of these claims, as applied to claims 1 and 7 above, except for teaching that the valves are actuated at different pressures, or that a valve is closed once another is opened, although Maloney does disclose that the valves would be arranged according to methods known in the art (col. 3, lines 35-45). Wellington et al. teach that known methods of operating gas lift in a well include opening a first valve in response to a first pressure and a second valve in response to a second, different pressure (col. 2, lines 67-68); wherein once a second valve is opened, the first closes (col. 3, lines 4-6); and wherein the valves are configured to sequentially activate (col. 3, lines 1-4). It is noted that the gas lift valves of Wellington are on the production tubing above the perforations, but the teachings as applicable to any gas lift system are considered equivalently relevant to the system of Maloney et al. since the principles of operation are the same. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to operate the valves of Maloney et al. as applied to the system and methods of McCulloch, as is known in the art and taught by Wellington, since applying a known technique to a known device where the result yields predictable results is considered obvious to one of ordinary skill.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Andrews whose telephone number is (571)272-6558. The examiner can normally be reached on M-F, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571)272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Bagnell/  
Supervisory Patent Examiner, Art Unit 3672

DLA  
3/3/10